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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,215	09/25/2001	Richard N. Ellson	7610-0001.25	2031

23980 7590 10/06/2003

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EXAMINER	
BAKER, MAURIE GARCIA	

ART UNIT	PAPER NUMBER
1639	10

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

File

Office Action Summary

Application No.	Applicant(s)
09/964,215	Ellson et al
Examiner	**Art Unit**
Maurie G. Baker, Ph.D.	1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *THREE* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Jul 15, 2003* .

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above, claim(s) *14-21* is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-13* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). *2, 3 & 4*
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

1. Applicant's Responses filed April 7, 2003 and July 15, 2003 (Papers No. 7 & 9) are acknowledged. No claims were added, amended or cancelled in these papers. Therefore, claims 1-21 are pending.

Election/Restriction

2. Applicant's election of Group I (claims 1-13) in Paper No. 7 is acknowledged. Election was made without traverse. Therefore, claims 14-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.

3. The election of species with traverse in Paper No. 9 is also acknowledged. The traversal is addressed below.

4. Applicant argues that the two species are "linked through the common concept of using *focused acoustic ejection* to generate droplets of a molecular moiety in a fluid". This argument is found persuasive and the election of species requirement is withdrawn.

5. Thus, claims 1-13 are under examination.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

7. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9, 13 and 27-33 of U.S. Patent No. 6,612,686.

> An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim not is patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re*

Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

The conflicting claims are not patentably distinct from each other because the claims of the patent are drawn to a "method for forming a combinatorial library" while the instant claims are drawn to a "method for generating an array of molecular moieties". The methods of making the library or array are performed utilizing nearly identical methods of applying focused acoustic energy. As a combinatorial library is within the scope of an array of molecular moieties, the examined claims would be anticipated by the reference claims. Note that U.S. Patent No. 6,612,686 also discloses biomolecules (patented claims 6-8), arrays (patented claims 27-31) and porous substrates (patented claims 28, 29, 32 & 33).

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9. Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 45, 46, and 50-52 of U.S. Patent No. 6,548,308.

An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim not is patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

The conflicting claims are not patentably distinct from each other because the claims of the patent are drawn to a "method for generating an array of droplets" comprised of two immiscible fluids while the instant claims are drawn to a "method for generating an array of molecular moieties" (where the moieties are present in a fluid and delivered to the surface as droplets). The methods of making the arrays are performed utilizing nearly identical methods of applying focused acoustic energy. As an array of droplets comprised of two immiscible fluids is within the scope of an array of molecular moieties (where the moieties are present in a fluid and delivered to the surface as droplets), the examined claims would be anticipated by the reference claims. Note that U.S. Patent No. 6,548,308 also discloses biomolecules reading on those instantly claimed (patented claims 50-52).

10. Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 40, 41, 44-47, 49, 54, 55 and 57-60 of copending Application No. 09/964,212 (Patent Application Publication US 2002/0037579).

An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim not is patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re*

Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

The conflicting claims are not patentably distinct from each other because the claims of the patent are drawn to a "method for generating an array of chemical entities" while the instant claims are drawn to a "method for generating an array of molecular moieties". The methods of making the arrays are performed utilizing nearly identical methods of applying focused acoustic energy. As an array of chemical entities is within the scope of an array of molecular moieties, the examined claims would be anticipated by the reference claims. Note that copending Application No. 09/964,212 also discloses biomolecules (patented claims 44-47) and porous substrates (patented claims 54 & 55).

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11. Claims 1-5 and 9-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 7, 13 and 33-37 of copending Application No. 09/963,173 (Patent Application Publication US 2002/0037359; on PTO-1449).

An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim not is patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re*

Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

The conflicting claims are not patentably distinct from each other because the claims of the patent are drawn to a "method for preparing an array" of peptidic molecules or a "method for preparing a peptide array" while the instant claims are drawn to a "method for generating an array of molecular moieties"; the moieties can be peptidic (see examined claim 9). The methods of making the arrays are performed utilizing nearly identical methods of applying focused acoustic energy. As the array of peptidic molecules or peptide array is within the scope of an array of molecular moieties, the examined claims would be anticipated by the reference claims. Note that copending Application No. 09/963,173 also discloses porous substrates (patented claims 33 & 34).

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12. Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 32-37 of copending Application No. 09/962,731 (Patent Application Publication US 2002/0042077; on PTO-1449).

An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim not is patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re*

Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

The conflicting claims are not patentably distinct from each other because the claims of the patent are drawn to a "method for synthesizing an oligonucleotide array" while the instant claims are drawn to a "method for generating an array of molecular moieties"; the moieties can be oligonucleotides (see examined claim 7). The methods of making the arrays are performed utilizing nearly identical methods of applying focused acoustic energy. As the oligonucleotide array is within the scope of an array of molecular moieties, the examined claims would be anticipated by the reference claims.

Status of Claims/ Conclusion

13. No claims are allowed.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: US 6,596,239, issued from US Application No. 09/735,709 mentioned in applicant's letter of December 2, 2002 (Paper No. 5).

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is (703) 308-0065. The examiner is on an increased flextime schedule but can normally be reached on Monday-Thursday and alternate Fridays from 9:30 to 7:00.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang, can be reached at (703) 306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D.
September 30, 2003

MAURIE GARCIA BAKER PH.D
PRIMARY EXAMINER